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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,118	11/18/2003	Takayuki Yajima	848075/0061	6090
29619 7590 12/23/2008 SCHULTE ROTH & ZABEL LLP ATTN: JOEL E. LUTZKER 919 THIRD AVENUE NEW YORK, NY 10022				
EXAMINER				
MA, CALVIN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/716,118

Applicant(s)

YAJIMA, TAKAYUKI

Examiner

CALVIN C. MA

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Finke-Anlauff (U.S. Patent: 6,850,226).

As to claim 24, Finke-Anlauff discloses the portable terminal unit comprising:

a first housing having at least a display section (i.e. the display unit 2 has a display 6 situated on it) (see Fig. 3, Col.2, Lines 53-65);

a second housing (i.e. the main body of the terminal unit 1) having at least a main operation section (i.e. the keyboard section 12 under which the main processor is situated inside the body 1), wherein both said first housing and said second housing are coupled together (i.e. the display unit 2 and the main unit 1 is coupled together with flexible join) (see Fig. 3) so that said main operation section is covered with said first

housing in a closed state and is exposed in an opened state, and said display second is exposed in both of said closed state and said opened state (i.e. in the closed state the display covers the keyboard and thus most of the body 1, Fig. 6, and in open state the display unit 2 is slide out and the keyboard 12 and the body 1 is uncovered by the unit 2) (see Fig. 3, 6, Col. 3, Lines 1-26);

an auxiliary operation section provided on either said first housing or said second housing other than on surfaces of said first housing and said second housing opposed to each other in said closed state (i.e. key unit 7 is not covered by the display on the closed state) (see Fig. 1); and

a control section for controlling said display section to display a selecting screen thereon in said closed state by an operation of said auxiliary operation section (i.e. the main control process 25 controls the auxiliary key input as well as the display 2 via the display driver) (see Fig. 8, Col. 4, Lines 28-37), for controlling said display section to display a message screen thereon in response to that a specific item is selected from a plurality of items shown in the selecting screen by an operation of said auxiliary operation section (i.e. in figure 1, it is clear demonstrate that the user of the device can select via the curser button 13 the caller the user wish to access with the highlighted bar over the selected name), and for controlling said display section to display a display screen image corresponding to the specific item thereon when said portable terminal unit is brought into said opened state after the message screen is displayed (i.e. when the screen is said to be opened the orientation of the display is changed automatically which is controlled by the main processor 25) (see Fig. 3,4,8, Col. 4, Lines 34-36).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Finke-Anlauff (U.S. Patent: 6,850,226).

As to claims 8, Finke-Anlauff discloses a portable terminal unit (i.e. the device 30) comprising:

a first housing (i.e. screen panel 2) having at least a display section (i.e. display 6) (see Fig. 1, Col. 2, Lines 50-65, Col. 3, Lines 5-10);

a second housing (i.e. body 1) having at least a main operation section (i.e. since the body contains the processing parts of the device, in contains the main operation section) (see Fig. 1, Fig. 5, Col. 2, Lines 49-53), wherein both said first housing (2) and said second housing (1) are coupled together (i.e. the display panel is attached to the body 1) (see Fig. 1) so that said main operation section is covered with said first housing in a closed state and is exposed in an opened state (i.e. since the screen panel

covers most of the body when the device is closed, the main operation section is covered by the display) (see Fig. 1), and a display screen of said display section is exposed in both said closed state and said opened state (i.e. the screen panel is always in view, and is therefore exposed in both the closed and open state) (see Fig. 1, Lines 50-65);

a state detecting section (i.e. 29 panel position sensor) for detecting whether said first housing and said second housing are in said opened state or in said closed state (i.e. the panel position sensor senses whether or not the panel is in open or closed position, since when the screen panel is opened the user is able to use the larger keyboard it would serve to the users convenience to rotate the screen orientation so that it will be in a landscape mode, which is allowed by the automatic sensor which uses software control to switch the orientation mode when the panel is opened) (see Fig 8, Col. 4, Lines 30-35);

and a control section (i.e. the main control process 257) (see Fig. 8) said display section (2) when said at least one key is operated in said closed state and opened state (i.e. the direction arrow by design will navigate a cursor on the screen regardless whether the screen is in open or closed position as Fig. 1 clearly demonstrate dark underlining cursor that is controlled by the directional cursor key 13) (see Fig. 1, Col. 4, Lines 1-2) and wherein the closed state said control section controls said display section to display thereon a item selecting screen for selecting an item from a plurality of items, and

wherein in response to the selection of an item from a plurality of items, and a state change from the closed state to the opened state, the control section controls said display section to change into displaying into displaying a screen image corresponding to the selected (i.e. since the movement of the cursor key is used to select the software application in use which also is accessed by the application key 8, the computer processor inside the portable unit account for both the display position and the current application selected allowing the portable unit to function properly select the specific item and setting the correct display orientation for the user according to the display position and the application selected) (see Fig 1, Fig 8, Col. 4, Lines 15-48).

Also, even if it is determined that the orientation is not directly connected to the section of an item selected by the cursor key, it would have been obvious one of ordinary skill in that art at the time the invention was made would have realized that the advantage of switch applications during the operation of the portable unit is added flexibility and it is common practice for the user to switch the applications, which can be accomplished by the cursor key access which would be able to allow the portable unit to change to a different application and therefore change the display orientation according to the new application need.

As to claim 22, Finke-Anlauff teaches an auxiliary operation section (i.e. telephone keypad 7) comprising at least one key (i.e. the telephone keys such as the numeral keys and the directional control keys) (see Fig. 1, Fig. 5, Col. 3, Lines 55-62)

provided on either said first housing or said second housing other than on a surface (i.e. the keys are on the body and always exposed) (see Fig 1, Col. 3, Lines 55-62), of said first and second housings opposed to each other in said closed state (i.e. the screen panel 2 is on top of the body 1 and therefore opposed each other in the closed state) (see Fig. 2b, Col. 2, Lines 50-60);

As to claims 1 and 21, see discussion of claims 8 and 22 above, claim 1 is analyzed to be broader than claim 8 and is rejected on the same ground.

As to claims 15 and 23, see discussion of claims 8 and 22 above, claim 15 differs only from claim 8 in the limitation of "a coupling section which rotatably couples said first housing and said second housing". Finke-Anlauff teaches a coupling section which rotatably couples said first housing (2) and said second housing (1) (i.e. the rotation by a pivot pin about the axis of the pins 38 that can also slide in a track 18, in this way the device is additionally given the rotational capability) (see Fig. 4, Col. 3, Lines 15-25).

As to claim 9, Finke-Anlauff teaches the portable terminal unit (30) according to claim 8, wherein said selecting screen displays a plurality of function items (i.e. the device is said to have PDA functionality and specifically allow the user to select function such as video camera 11, calendar data 26, contact data 27, and internet browser 28) (see Fig. 8, Col. 4, Lines 20-30).

As to claim 10, Finke-Anlauff teaches the portable terminal unit according to claim 9 wherein said function items are a mail function (i.e. email), a memorandum function (i.e. notes), a schedule book function (i.e. calendar function), a browser function (i.e. Internet browser 28), a message/voice memorandum function (i.e. in cellular telephony the message and voice memorandum functions are network provided, for a cellular phone to provide service to the user, it is an understood function built-in to the phone), a history function and a camera (i.e. video camera 11) function (i.e. since the device is able to handle full PDA functionality and all application that software packages such as Microsoft Office handles, all of the above functionality are present)(see Fig. 8, Col. 2, Lines 35-47, Col. 4, Lines 20-30).

As to claim 11, Finke-Anlauff teaches the portable terminal unit according to claim 8, wherein said selecting screen displays a plurality of selecting items for one function item (i.e. since the device 30 is able to allow the user to select and operate functions such as internet browser, which allows the user to select plurality of items in the browser to allow proper functionality) (see Fig. 8, Col. 4, Lines 20-30).

As to claim 12, Finke-Anlauff teaches the portable terminal unit according to claim 8, wherein said portable terminal unit (30) is a mobile telephone (i.e. mobile telephone 21) (see Fig. 1, Col. 4, Lines 15-16).

As to claim 13, Finke-Anlauff teaches the portable terminal unit according to claim 8, wherein said portable terminal unit (30) is a personal digital assistant (i.e. the device function as a personal digital assistant) (see Col. 4, Lines 22-24).

As to claim 14, Finke-Anlauff teaches the portable terminal unit (30) according to claim 8, wherein said first housing (2) and said second housing (1) are coupled to each other so as to be opened and closed by a sliding motion (i.e. screen panel 2 slide over keyboard 12 of the body 1) (see Fig. 3, Col. 2, Lines 58-60)

As to claims 2-7, see discussion of claim 9-14 above, claims 2-7 are analyzed to be broader than claims 9-14, and are rejection on the same ground.

As to Claims 16-20, see discussion of claim 15 above, these claims are analyzed as equivalent to claims 9-13 with respect to the parent claim, claim 15, and is rejected for the same reason.

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finke-Anlauff in view of Chetty (US Pub: 2002/0052193).

As to claim 25, Finke-Anlauff does not explicitly teach wherein the message screen prompt a user to change the state of the portable device, however refers to the ability for the user to manually accomplish the task. Chetty teaches the message screen prompt a user to change password by entering it to allow for information transmission (see Chetty, Fig. 16, [0095]).

Therefore, it would have been obvious for one of ordinary skill in that art at the time the invention was made to have adapted the user interaction method of Chetty to prompt a user to change a state of the computing device to the mobile communication system of Finke-Anlauff in order to enable addition operation security of the device (see Chetty [0003]).

Response to Amendment

6. Applicant's reply was received in the Office on 10/14/2008 and the new claims 24-25 have been entered.

Response to Arguments

7. Applicant's arguments filed 10/14/2007 have been fully considered but they are not persuasive. As to claims 1, 8 and 15 in pages 9-11 of the remark, the applicant argue that the '226 patent does not disclose orientation is connected to the selection of an item by the cursor. The examiner disagrees, since the '226 patent does teach the user being able to select items on a scrolling bases (see Fig. 1) by using the cursor key

this is clearly selecting a specific item from a plurality of items on the screen which is necessary in changing the applications that can be displayed on the display system 6 which is a precursor to the change in the application which will change the orientation of the display according to the said application's need.

Also in second paragraph pages 10 of the remark, the applicant argues that the prior art '226 fails to disclose the feature of changing the screen image in response to a selected item and changing the state of device by moving it from the closed state to the open state". The examiner disagrees with this logic since the prior art clearly states in column 4 lines 30-47 that the orientation changes when the application changes and the change is triggered when the display is extended which is create the open state where the keyboard is accessible by the user.

As to argument regarding claim 24 in second paragraph of page 11 of the remark, the examiner disagrees with the assertion that "controlling said display ... after the message screen is displayed" since the figures 1-6 in the prior art '226 clearly demonstrate that the screen displayed by the mobile unit contain the same information prompt which highlight bar in both orientations where the user can access with the cursor keys regardless of open or closed position the computer system controls both the main keyboards and auxiliary keypad that is always exposed. In this way the prior art still read on the new claimed limitation.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Ma whose telephone number is (571) 270-1713. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Calvin Ma
Dec 20, 2008

/Chanh Nguyen/
Supervisory Patent Examiner, Art
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